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c/o SUSAN TRADER				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1                   RECORD OF ORAL HEARING  
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3                   UNITED STATES PATENT AND TRADEMARK OFFICE  
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6                   BEFORE THE BOARD OF PATENT APPEALS  
7                   AND INTERFERENCES  
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10                  Ex parte CARL JOSEPH KRAENZEL,  
11                  KATHERINE A. SPANBAUER and MARK A. NOWACKI  
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14                  Appeal 2009-2793  
15                  Application 10/091,573  
16                  Technology Center 3600  
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19                  Oral Hearing Held: June 23, 2009  
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23                  Before MURRIEL E. CRAWFORD, ANTON W. FETTING  
24                  and JOSEPH A. FISCHETTI, Administrative Patent Judges.  
25

26                  ON BEHALF OF THE APPELLANT:

27                  James G. Gatto, Esquire  
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35                  The above-entitled matter came on for hearing on Tuesday, June 23,  
36                  2009, commencing at 1:29 p.m., at the U.S. Patent and Trademark Office,  
37                  600 Dulany Street, Alexandria, Virginia, before Daniel Greenwald, Notary  
                    Public.

1           MS. BOBO-ALLEN: Calendar No. 55. Appeal No. 2009-2793. Mr.  
2 Gatto.

3           JUDGE CRAWFORD: Good morning.

4           MR. GATTO: Good morning.

5           JUDGE CRAWFORD: Oh, you're on both cases. Okay. I hadn't  
6 noticed --

7           MR. GATTO: Yeah, I got a two for today.

8           JUDGE CRAWFORD: I hadn't noticed that before.

9           MR. GATTO: Yes, thank you.

10          JUDGE CRAWFORD: Okay.

11          MR. GATTO: I'll be very brief on the first one.

12          JUDGE CRAWFORD: All right.

13          MR. GATTO: I think it's clear in this case that the Examiner admits  
14 that the recitations of enabling a user to declare and associate information  
15 with one or more topics is not disclosed in the, in the prior art. The  
16 Examiner admits that.

17          The issue, what it comes down to then is that the Examiner instead  
18 tries to argue first that this is -- this may be inherently disclosed in the prior  
19 art. If you look at the Examiner's Answer at page 9, to say that something  
20 may inherently be disclosed is actual a legal oxymoron. As we know,  
21 inherency means that the characteristic relied on in the prior art must  
22 necessarily be present.

23          JUDGE CRAWFORD: Well, now, you know, looking at that  
24 enabling clause, to me it looks like what this clause says is, and I think the  
25 Examiner was saying this, is that it permits the user to enter in this data.

1           MR. GATTO: Right. Two things. First of all it does. If in the  
2 context of this computer implemented invention you look at figure 4, for  
3 example, there is a GUI presented to the user that enables a user to enter,  
4 declare a topic and associate information. So yes, it does permit the user to  
5 do that, and then the claim recites that you store the declared topic and the  
6 associated information. So when you read the claim as a whole, it's clear  
7 that there has to be a declaration that's stored in the system, and then you  
8 further process that.

9           JUDGE CRAWFORD: Yeah, but the declaration is just entering  
10 something in.

11          MR. GATTO: Well, it's entering a specific something in.

12          JUDGE CRAWFORD: Okay.

13          MR. GATTO: The claim specifically recites declaring a topic and  
14 associating information, and the Examiner admits that that information is not  
15 disclosed in the reference.

16          JUDGE CRAWFORD: But then he said that that's just printed  
17 matter. I mean the -- what -- the information that's put in would not patently  
18 distinguish it from the reference.

19          MR. GATTO: But storing specific -- the claim recites enabling the  
20 user do, and it's a GUI that is what enables the user to do it. True, the user  
21 enters information, and that information is stored. The claim specifically  
22 recites that. So the fact that you're presenting a GUI and storing information  
23 that's entered, that's not simply printed matter. That's how almost every  
24 computer, you know, system has some aspect of user interaction, storing  
25 information and then subsequent processing. So I think the Examiner's  
26 argument regarding nonfunctional descriptive material, the Examiner

1 recognizes that these claimed elements are not in the prior art, and he tries to  
2 do a bit of legal hand waving and say well, I'm not going to give any  
3 patentable weight to this.

4 But I don't know how in the context of a computer method if you say that  
5 you're enabling a user to do something by presenting a GUI and then storing  
6 that information, right, that can't be just printed matter. There's just no legal  
7 basis for that.

8 And as far as the specific information, what the Examiner alleges is that this  
9 may inherently be disclosed in the prior art. And again, as I said, for  
10 something to be inherent, it must necessarily be disclosed. You can't have  
11 something that may be inherently disclosed.

12 JUDGE FISCHETTI: What is the connection between the content  
13 and the process that you say is being driven by that content?

14 MR. GATTO: Well, again, I think if I understand the question  
15 correctly, the first recitation by saying you're enabling a user to declare  
16 topics and associate information, you're presenting a GUI to enable the user  
17 to do that. And then the second step is storing the declared topics and  
18 associated information so that there's a tangible tying of the entered  
19 information into the system, and then there is the subsequent processing of  
20 that information.

21 JUDGE FETTING: But given that it's just information that -- isn't  
22 that the Examiner's point is fine, this -- the data entry and storage are  
23 patentable steps. But data is data. It's just bits, and what those bits  
24 represent is just non -- cannot define over the prior art.

25 MR. GATTO: Well, but I think part of the problem is the Examiner is  
26 trying to improperly dissect the claim in saying okay, well, you have use of

1 information. But that's not what the claim says. I'm not saying just  
2 enabling the user to enter any information. There is specific information, a  
3 declared topic and associated information and that -- throughout the claim,  
4 that specific type of information that the user enters and gets stored is then  
5 processed for the particular purpose recited in the claim. So you can  
6 monitor users' activities and determine if someone is interested in that  
7 declared topic.

8 All right, and so again, I think it's another legal error that the  
9 Examiner kind of truncates the claim element and say that, you know, this,  
10 you know, there's information being entered. True -- that's true in almost --  
11 in most computer systems. You're either entering information, processing  
12 information, but if we were to analyze claims like that for purpose of  
13 patentability, then you'd be ignoring specific recitations. If we just said  
14 entering information, there may be more of an argument there, but it's  
15 specific type of information for a specific purpose, and there's subsequent  
16 claim elements that, that relate to that and tie back to that purpose and the  
17 overall context of the invention.

18 JUDGE FETTING: But if you simply say storing a particular type of  
19 information, and that's all there is to it then any -- then that particular type of  
20 information is nonfunctional descriptive material. The -- it is a predictable  
21 application of simply storing material. Unless you functionally rely upon  
22 the nature of that data later on in the claim, it seems as though it's just  
23 nonfunctional.

24 MR. GATTO: Well, again, I think if we take a step back, look at the  
25 claim as a whole, okay, you can't focus just on the information. The claim  
26 is a method, and it recites certain steps. Enabling the user to do something,

1 storing the result of what the user does, then determining if based on the  
2 information stored if certain other activity meets that and then notifying. So  
3 in a method claim you need to look at the steps.

4 Now I agree in connection with those steps there is information. But  
5 to simply say that, you know, the claim is reciting information, therefore it's  
6 printed material, is ignoring the fact that there's four method steps recited.

7 JUDGE FETTING: Okay, so let's get to the next steps then and see  
8 how it all ties together.

9 MR. GATTO: Okay. So -- and again, I just to take one more step  
10 back, I think one thing that's important in connection with the prior art, it's  
11 clear that in the prior art it's a passive system as we argued. The user  
12 doesn't declare anything. So in the prior art, if you're just monitoring user  
13 activity, you may be notified of things you really don't care about, right.  
14 You may be given a task about a topic you don't like and the system, they  
15 say okay, well, you're associated with this task and send you information.

16 JUDGE CRAWFORD: I don't know that your claim has the user  
17 declaring anything either.

18 MR. GATTO: The --

19 JUDGE CRAWFORD: You've got enabling a user to declare.

20 MR. GATTO: And then storing declared, past tense, topics, right.  
21 When you read the claim as a whole, right, you know, we typically don't  
22 recite a user performing a step, because under BMC and Union Auction  
23 (phonetic sp.) it's hard to prove infringement. So if you enable -- if you  
24 affirmatively enable a user to do it, in this case it's clear that's a GUI that  
25 you're presenting, and then you store declared information, right, when you  
26 read those two together, the user has to have declared something for you to

1 be able to store declared information, right. So I think that when you read  
2 those together, right, it's pretty clear that they're presenting an option for a  
3 user to do it via a GUI and then storing what's declared and associated.

4 JUDGE FISCHETTI: So you're inferentially saying by virtue of the  
5 past tense use of declared that it was -- that the previous step basically was  
6 occurred. Is that what you're saying?

7 MR. GATTO: It would -- a user would -- something would have to  
8 be declared by the user for there -- for that to be stored, correct. But --

9 JUDGE FETTING: In the second step, where does it say that the  
10 declared topics are in fact the same topics that were enabled to be declared  
11 in the first step?

12 MR. GATTO: It recites storing declared topics. The -- two  
13 comments there. I mean it's clear in the context of the claim as a whole  
14 that's the only other recitation of declared topics is what's enabled but --

15 JUDGE FETTING: Could have been from outside of the scope of the  
16 claim.

17 MR. GATTO: But even if that interpretation was adopted, there is  
18 absolutely nothing in the prior art that's relied on where there's a declared  
19 topic. You're simply monitoring user activities. There is no declaration of a  
20 topic by the system or by the user in the prior art. So even if the claim were  
21 interpreted that way, which is not how we think it should be interpreted, but  
22 even if it was, the prior art still doesn't meet the claim elements.

23 JUDGE FETTING: So we're back to the nonfunctional description of  
24 material characterization.

25 MR. GATTO: Right, which we believe is -- I mean again, there's  
26 affirmative recitation of steps, including storing declared topics, that that's

1 not merely descriptive material. You're actually performing a computer  
2 implemented step in connection with certain information.

3 JUDGE FETTING: You know, this nonfunctional printed material  
4 came from In re Ngai which was printed instructions. Are you -- is your  
5 position that if In re Ngai had been storing or reading back their instructions  
6 from a computer rather than being on a printed piece of paper, it would have  
7 come to a different conclusion?

8 MR. GATTO: Not necessarily. I mean if you're simply providing  
9 instructions, that's one thing, but providing a GUI such as shown in figure 4  
10 is not just instructions. I mean that is in the context of a computer  
11 convention, if you're providing a GUI that enables you to do something or  
12 providing a menu, right, that -- there's a functional component to that. It's  
13 not just instructive material as the Examiner alleges. That's the error.

14 JUDGE FETTING: Okay, so again, it comes back to how you're  
15 going to use this later on in the claim so --

16 MR. GATTO: In part, but I think that in and of itself, you know --

17 JUDGE FETTING: If all you're doing is storing the information, how  
18 can the whatever information you're storing define over the prior art?

19 MR. GATTO: Because it's not just storing it, because you then  
20 subsequently monitor the computer activities of a user and determine if a  
21 user is interested in a declared topic. In other words, there's a set of specific  
22 steps that use --

23 JUDGE FETTING: That's what I keep saying. Okay, let's see how  
24 this is used later on.

25 MR. GATTO: Yes. Yeah, okay.

26 JUDGE FETTING: Okay.

1           MR. GATTO: So -- and I'm sorry. I thought I addressed that earlier,  
2 but yeah, there are the subsequent steps of monitoring, determining and  
3 notifying --

4           JUDGE CRAWFORD: But those are shown in the prior art.

5           MR. GATTO: But not with respect to the --

6           JUDGE CRAWFORD: With only difference being the data.

7 Whereas the prior art is monitoring I guess text proximate determinations,  
8 and you're monitoring key words and topics.

9           MR. GATTO: Well, but again, it's monitoring a declared -- I mean a  
10 declared topic, something that you declare you're interested in, okay. It's  
11 not just a piece of information. There's -- it's not -- it's, you know, the  
12 declaration applies an affirmative act. As we kind of argue, it's an active  
13 system as opposed to a passive one in the prior art where there is no  
14 declaration, there is no declared topic. Okay, and that -- in the context of the  
15 invention, that presents a distinction over the prior art.

16          The -- there's not -- I mean the Examiner is not saying that you  
17 can't -- I mean manipulating certain types, specific types of information,  
18 right, the steps that you perform are not merely descriptive, right. And there  
19 is no prohibition on -- I mean there's, there's a number of cases where, you  
20 know, part of what makes an invention different in the context of a computer  
21 invention is what type of information are you processing? What is the  
22 information? This information, it's clear that it's declared topics and  
23 associated information. All right, and so you're performing specific steps on  
24 that, and that's what distinguishes over the prior art.

25          JUDGE CRAWFORD: What -- how do you respond to the Examiner  
26 saying that the topic and the declared information that you're talking about

1 being topics and keywords is well-known -- are well-known parameters for  
2 searching? So even if Tang doesn't disclose them, it would have been  
3 obvious to modify it for keywords and --

4           MR. GATTO: Well, I think there's two arguments there. One, I  
5 mean that -- even if that statement is true in and of itself, it's not relevant to  
6 the 103 inquiry, because A, Tang doesn't disclose that. Tang is clearly a  
7 passive system, and the Examiner acknowledges that, and there's no rational  
8 underpinning for saying okay, because Tang is a passive system that we're  
9 now going to convert it and say we'll have a declared topic in Tang. All  
10 right, it's inconsistent with the teaching of Tang which is basically a passive  
11 system --

12           JUDGE CRAWFORD: I'm kind of off the declared part of it. Just  
13 let's talk about topic and keyword.

14           MR. GATTO: Well, then I think if you just look at topic then you're  
15 not reading the claim element as a whole. It's a declared topic. We're not  
16 saying just search a topic. Right, I will admit that searching topics in  
17 general, right, may be known in the prior art, but that's not dispositive of any  
18 issue with respect to obviousness. If we only recited searching a topic, then  
19 that would be a relevant inquiry. But this talks about storing a declared topic  
20 and then determining if the user is interested in the declared topic. You  
21 cannot ignore the express recitations in the claim.

22           JUDGE CRAWFORD: I understand your point.

23           MR. GATTO: Unless you have any further questions, I have nothing  
24 further on that.

25           JUDGE CRAWFORD: All right, on to the next one.

26           (Whereupon, the hearing concluded on June 23, 2009.)